

**REMARKS**

At the outset, Applicants wish to thank Examiner Low for the courtesies extended to Applicants' representatives during their telephonic interview on July 20, 2010. The substance of the interview is incorporated in the following remarks.

**Summary of the Office Action**

In the Office Action, claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,034,382 to *Hazel*.

**Summary of the Response to the Office Action**

Applicants amend independent claim 1 to better define the present invention. Accordingly, claims 1-3 are presently pending.

**All Claims Comply With 35 U.S.C. § 102(b)**

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Hazel*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Hazel* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 1 recites, in part, "the clincher piece being disposed so as to be opposed to a striking position of a staple and to be rotatable; and a clincher cam rotatable about a shaft including a cam surface directly engageable with the movable clincher so as to rotate the movable clincher, the clincher cam being driven through a drive link directly operated by a drive mechanism for driving a staple into the binding

sheets.” The Office Action equates *Hazel* with the claimed invention, but *Hazel* does not show at least the features recited in claim 1.

*Hazel* does not disclose at least “the clincher piece being disposed so as to be opposed to a striking position of a staple and to be rotatable,” as recited in newly amended claim 1. In *Hazel*, the alleged clincher piece 25 is not opposed to the striking position of alleged staple 15, which is the position of the staple legs 13 when they are penetrating the binding sheets 17. The alleged clincher piece 25 in *Hazel* is not shown opposed to this striking position in any of Figs. 2-7. Further, the alleged clincher piece 25 in *Hazel* is not “rotatable” as claimed, but rather it translates linearly to trim and clinch the resistor’s legs. Thus, *Hazel* fails to teach or suggest each and every feature of claim 1.

The Office Action asserts that the cam surface of member 43 (alleged clincher cam) of *Hazel* is “directly engageable” with member 25 (the alleged clincher piece) and members 25, 29 (the alleged movable clincher) via members 31, 33, and 35 because the bias of spring 37 keeps them always connected or engageable. The assertion by the Office Action is these components are always connected or engageable so they must be “directly” connected or engageable. The Office Action asserts that components (43 and 25, 29) are “directly” engageable because they are always engaged to each other, but always engageable does not equate to directly engageable. This assertion in the Office Action is false because the cam surface of member 43 is not directly connected to or engageable with members 25 or 29. The plain meaning of the term “directly” (*e.g.*, without anything intervening) precludes the always interpretation proffered in the Office Action. See page 3 of the Office Action.

Figs. 3-4 of the present invention show the cam surface 16a of the clincher cam 16 is “directly” engageable with the movable clincher 11. That is, there is nothing intervening between them. Thus, *Hazel* cannot satisfy “a clincher cam rotatable about a shaft including a cam surface directly engageable with the movable clincher so as to rotate the movable clincher,” as recited in independent claim 1.

Additionally, *Hazel* does not disclose at least “the clincher cam being driven through a drive link directly operated by a drive mechanism for driving a staple into the binding sheets.” *Hazel* does not show any drive link operated by a drive mechanism for driving a staple into the binding sheets. The alleged drive link (shaft 45) of *Hazel* must be operated by a drive mechanism that can also drive a staple. *Hazel* does not disclose a device or a component of the trim and clinch device to drive the alleged staple into the binding sheets.

Nevertheless, the Office Action asserts that *Hazel* is “capable of” stapling sheets together. The specification in *Hazel* discloses that the leads (11, 13) of an electronic component (15) are *inserted* in a hole formed in a printed circuit board 17 and positioned between trimmer elements 23 and 25. See col. 3, lines 34-38 of *Hazel*. First, the alleged staple (an electronic component 15) is inserted and not driven in *Hazel*, as driving an electronic component like a staple would damage it. Second, if the alleged drive link (shaft 45) is directly operated by a drive mechanism for driving a staple, it is a mystery how the unidentified drive mechanism drives the alleged staple (an electronic component 15) into the alleged binding sheets in Fig. 1 of *Hazel*. There is no structure shown or discussed alleging communication between the unidentified drive mechanism and the alleged staple (15). Applicants note that the Office Action argues the phrase

“capable of” to suggest *Hazel*’s device can drive a staple, but this phrase is not found in claim 1. Thus, the Office Action is erroneously asserting claim language not present in claim 1. As such, *Hazel* fails to teach or suggest each and every feature of claim 1.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Hazel* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-3 are also allowable insofar as they recite the patentable combinations of features recited in independent claim 1, as well as reciting additional features that further distinguish over the applied prior art.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

By: /David E. Connor/  
David E. Connor  
Reg. No. 59,868

Dated: August 5, 2010

**CUSTOMER NO. 009629**  
**MORGAN, LEWIS & BOCKIUS LLP**  
1111 Pennsylvania Avenue, NW  
Washington, D.C. 20004  
Tel.: (202) 739-3000  
Fax: (202) 739-3001